

No. 11,445

IN THE

United States Circuit Court of Appeals

For the Ninth Circuit

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STUART OXYGEN Co., LTD.,

*Appellant,*

VS.

WILLIAM JOSEPHIAN,

*Appellee.*

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BRIEF FOR APPELLEE.

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BOYKEN, MOHLER & BECKLEY,

A. W. BOYKEN,

W. BRUCE BECKLEY,

Crocker Building, San Francisco 4, California,

*Attorneys for Appellee.*

REGINALD L. VAUGHAN,

Mills Tower, San Francisco 4, California,

*Of Counsel.*

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PAUL P. O'BRIEN,

CLERK.



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**BRIEF FOR APPELLEE.**

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**I. INTRODUCTION.**

Appellant-defendant in the above entitled case appeals from a final judgment of the U. S. District Court for the Northern District of California adjudging U. S. Letters Patent No. 2,317,064 issued to plaintiff-appellee on April 20, 1943, and particularly claims 1 to 4 thereof, valid and infringed by certain oxygen tank carrying trucks manufactured and used by appellant-defendant.\*

The suit involves only the question of infringement of said Letters Patent. *The question of validity is not in issue since the answer did not plead that defense (4-7). \*\**

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\*The parties will hereinafter be referred to as plaintiff and defendant as was true in the lower Court.

\*\*The record comprises two volumes of which the second is the Book of Exhibits. Numerals in parenthesis herein refer to the page numbers of said record. Italics as used throughout the brief, unless otherwise noted, may be considered ours.

## II. THE TESTIMONY CONSIDERED.

### A. THE INVENTION IS A DEVICE FOR MOVING A GROUP OF HEAVY GAS CYLINDERS SAFELY AND EASILY.

The record shows that the plaintiff, Josephian, was the patentee and owner of the patent in suit covering a Tank Truck for use in moving heavy gas holding cylinders (10-11). The patent, Plaintiff's Exhibit 1 (197-200), states its object as follows:

"It is another object of my present invention to provide means for clamping a plurality of tanks into a unit which can be readily moved from place to place by tilting and rolling, together with means for reducing the danger of upset \* \* \*

"My invention broadly therefor, is the grouping of several cylinders into a manoeuvrable unit capable of being handled by one man, and spotted easily without the aid of any mechanical device. The unit will not lose balance and tip over \* \* \*" (page 1, column 1, line 50 to column 2, line 9).

From the above, it is clear that no contention is made that the invention is a revolutionary discovery. It is simply alleged that the device provides novel means for safely and easily moving a plurality of heavy cylinders, a procedure which was, in the past, very slow, laborious and dangerous.

Oxygen, acetylene and other gases used commercially are normally supplied from heavy cylindrical tanks, delivered to the job by the manufacturer, each of which weighs in the neighborhood of 600 pounds (34-39). They must be replaced frequently and when new units are delivered, these must be attached to the main gas line by semi-flexible metal tubes called "pig-tails" provided with

couplings on their outer ends. Obviously it is desirable to connect the pig-tails with the least possible amount of shifting and moving of the tanks, both to avoid working the heavy cylinders about and to prevent breaking of the pig-tails. Since one man usually handles deliveries, the units must be made to be easily and accurately "spotted" without danger to the worker through upset and it is this object which the invention makes possible (38-40).

The present invention comprises a so-called truck on which a plurality of individual tanks may be secured for ease in such handling without danger of the unit tipping over and injuring the worker. The commercial embodiment of the invention is shown in Plaintiff's Exhibits 8A and 8B (209-210) and is also shown in the patent drawings (198).

Using the reference numerals of the patent (197-200), the unit comprises a bottom base plate 8 and a top plate 6 through which latter the outlet valves 4 of the gas tanks 1 extend. The two plates are connected, and thus hold the tanks in position, by means of tie-rods 9 positioned around their peripheries. A circular track 11 of somewhat smaller diameter than the base plate 8 is secured centrally of the latter's under side, as can best be seen in Figs. 1 and 3 of the patent drawings and in Plaintiff's Exhibit 8A. The function of this track is to permit the entire unit to be slightly tipped to one side so that it may easily be rolled along the track by one man. The track is so chosen in diameter and thickness that as the unit rests in the tipped position on both the track and the periphery of the base plate, it is in no danger of falling over and will require the application of a substantial addi-



tional force to make it do so. Thus the entire unit may be easily moved about by rolling to any exact and desired location without danger and without any more effort than is required to move a single tank (42). There is no evidence to show that a plurality of cylinders had ever before been connected together for such ease and safety in handling. The only so-called prior art, Defendant's Exhibits A1-A3, B1-B4, C1-C4 (231-241), comprised cranes, hand trucks or trailers for moving the cylinders.

In describing the operation and safety characteristics of the truck, the patent specification chooses the word "stable" to describe both positions (Figs. 1 and 3 of the patent) in which the truck is used and operated. There is the upright or normal stable position with the track flat on the floor, and the tilted stable position in which the unit is in a slanting position. Thus, if the unit slips while being tilted or rolled, it will come to rest in either one of these stable positions (see patent, page 2, column 1, lines 31-38).

Likewise, the specification points out that tracks of various diameters and thicknesses may be used depending upon the dimensions of the unit and the purpose for which it is to be used (page 2, column 2, lines 4-5). The specification further emphasizes that the particular application illustrated in the drawings is only "*one preferred form*". It clearly states:

"I wish it to be distinctly understood that the drawing given herewith is illustrative only, and that the relative diameters of track 11 and lower plate 8 may be varied as desired to control the amount of force necessary." (page 2, column 1, lines 43-47).



Thus, the specification and claims must be interpreted in this light and were clearly not intended to be restricted to the preferred form shown in the drawings. The patentee, William Josephian, testified that his purpose was to construct a multiple-unit truck which could be moved with a minimum of effort on the part of the worker and which had these safety positions to prevent injuring him should the unit "lose balance and tip over." For this reason, he provided the tilted stable position, from which "a second and preferably greater application of force will be necessary in order to tilt the unit still further laterally" (41-42).

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**B. NO PRIOR ART WAS CITED AGAINST THE INVENTION IN THE PATENT OFFICE AND NO ANTICIPATIONS ARE SET UP BY DEFENDANT.**

The history of the granting of the patent in suit and the proceedings here are of importance.

*In the first place, the Patent Office cited no art during the course of prosecution of the application and the first seven of the original eight claims submitted were allowed in the first Office action (224). The remaining claim was immediately cancelled and the patent issued without further prosecution except for a minor correction of the drawing (225-229). The Patent Office was thus quick to recognize the unique contribution made by the patentee in solving a problem that others had not solved.*

The second point which is of interest and which is unusual in an action for infringement is that the defense of invalidity was not pleaded in the answer and no claim has

been made by defendant that the invention is anticipated by the prior art; a recognition by the defendant of the merit and scope of the invention. As stated by the attorney for defendant, at the close of the evidence (170):

“We do not contest whether it is invention or not. I would be willing to admit that for the purpose of this case.”

The defendant has thus paid tribute to the invention by its admission of validity, its failure to cite any anticipating references, and by its use of the infringing device, the full equivalent of the invention.

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**C. THE INFRINGING DEVICE WAS DEVELOPED WITH THE JOSEPHIAN INVENTION IN MIND AND IS IDENTICAL WITH IT.**

The defendant's device is shown in Plaintiff's Exhibits 7A and 7B (207-208). Its similarity to plaintiff's device is marked, as well it might be, for *defendant, plaintiff's competitor, never used any type of four-cylinder truck until after the date of issuance of the patent in suit*, and then only after it had studied the plaintiff's patent and his commercial device (97-101). It is thus clear that defendant deliberately built a unit performing the functions of plaintiff's invention.

It appears that the patent had been brought specifically to the attention of defendant on several occasions prior to its building the devices alleged to infringe, once at a Detroit convention (53-56), again at a convention in Denver (56) and still a third time on a visit of defendant's employees to plaintiff's plant (57).

Defendant rendered further appreciation to plaintiff and his invention by employing a former employee of plaintiff (57-58) to help design the infringing truck (100-101).

The infringing device has a base plate in all respects similar to the Josephian base plate. Instead of a separate track on the bottom of defendant's device, there is provided a circular dished portion pressed out of the plate, and on which the device rests, as can best be seen in Plaintiff's Exhibit 7A. This dished portion is the full equivalent of the Josephian track (61-62) as admitted by Mr. Doble, defendant's expert, under questioning by the Court, when he stated that the difference between the two was "immaterial" (126).

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#### **D. THE DEVICES FUNCTION IN AN IDENTICAL MANNER.**

It appears from the patent specification (page 2, column 2, lines 4-11), and is not denied; that the height and the diameter of the Josephian track is variable depending upon the desired result. The particular track chosen for illustration in the patent is one which causes the entire unit to remain in the tilted stable position (see Fig. 3 of the patent) when all support is removed.

On the other hand, the defendant's device (Plaintiff's Exhibits 7A and 7B) will not remain unsupported in this titled position: it will tend to teeter back to the upright stable position.

Defendant has attempted to make much of this difference. That it is not important and is not the object of

the invention, however, appears from the testimony of the inventor that he fully realized that a slight variation in either the thickness or diameter of the track would cause it to operate differently. The particular track chosen for illustration and use was taken because a standard one-inch pipe could be used for the track (74-75).

*If the height of the ring under defendant's device is increased by a very slight amount, it, too, will remain in the tilted stable position, identically with the patent illustration.* This fact was forcibly demonstrated during the cross examination of Mr. Doble, defendant's expert. An aluminum plate (Plaintiff's Exhibit 10), and shown in Plaintiff's Exhibits 7A, 7B, 8A, and 8B (207-210), had been brought into the courtroom to protect the floor. The defendant's truck was so positioned that the dished portion was resting on the aluminum plate and the periphery of the base plate was overhanging the aluminum plate. *When the unit was tipped to the tilted stable position with the periphery of the base plate resting on the floor, the unit remained in the tilted position without any support whatsoever (147-149).* Mr. Doble was requested to measure the thickness of the plate and found it to be only 3/16" (149). From this, the lower court quickly and correctly concluded "that means that if the basal member were thickened by 3/16 of an inch on the defendant's device, it would come to rest in the same manner as plaintiff's device does" (149).

That the units are likely to be used under conditions where the floor is not level and that the device may well operate normally in this fashion was also brought out in

the testimony of a test made at one of defendant's installations. Mr. Metcalf, plaintiff's expert, testified that he had observed certain of defendant's devices under actual use. He stated that these units were used on a planked floor and that in certain places where the floor was slightly uneven, defendant's devices came to rest in the tilted stable position, the same as Josephian's (161-162).

It can only be concluded that defendant has knowingly taken and used the gist of Josephian's invention and is here relying on a technical definition of words in an attempt to avoid infringement.

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**E. A STABLE POSITION IS NOT ONE OF REST  
OR IMMOVABILITY.**

As has been stated above, the patent speaks of two *stable* positions, the upright stable position (Fig. 1) and the second or tilted stable position (Fig. 3). Because the claims in suit refer to this second stable position, the definition of the term is important.

The word *stable* is, at the outset, a relative term and does not imply immovability or rest. Both the New Standard Dictionary (1927) and Webster's New International Dictionary, 2nd Ed. (1941) define the word:

“\* \* \* not easily moved, shaken or overthrown.”

The defendant's own expert directly admitted that *stable* did not mean immovable but that it is a relative term (146). Mr. Josephian testified that the term “*stable*” did not necessarily mean a position of rest but



one "where the unit stops and a greater force has to be applied in order to bring it over before it falls down" (73).

Mr. Metcalf, the patent attorney who prepared and prosecuted the patent in suit (159), testified that the word stable as used in the patent, meant stable in the direction of overthrow or a place where an increased force is necessary to make it fall down. He also stated that a device need not be motionless to be stable, citing the examples of moving cars and airplanes (166-168).

In concluding this discussion, it is important to note that defendant's device, once placed in the tipped position, also requires a substantially increased force to cause it to overturn (165), just as is true of the Josephian unit. Thus, in spite of the fact that on a perfectly smooth floor defendant's device will teeter back to the upright position, it does reach a position stable as against overthrow, the main object of the patent in suit.

Plaintiff has no quarrel with the defendant's argument that a patentee is his own lexicographer and that the words of the claims find their definition in the specification. But reading that description in its entirety, and considering the definitions set forth (see page 2, column 1, lines 21-24, 31-47), it is clear that by a second stable position the patentee referred to a position, not of rest, but one where an additional force was required to overturn the unit.



### III. THE ISSUE.

The issue on appeal is exceedingly simple. The Josephian patent illustrates a device which, when tipped into the "second or tilted stable position" (Fig. 3), will remain in that leaning position. It will neither fall to the ground without the application of an appreciable additional force nor return to the upright stable position (Fig. 1).

The defendant's device differs only in that, when placed in a tilted stable position on a perfectly smooth floor; it will return, as by teetering, to the upright stable position.

Thus the only question for the Court, as is admitted in defendant's Statement of Points Relied Upon on Appeal (185-187), is simply whether defendant may escape the penalty for obvious infringement of the Josephian patent by decreasing the height of the ring by  $3/16''$  so that the device will not remain in the tilted position—a position described by the Court as a Leaning Tower of Pisa, in which no objective is accomplished (174).

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### IV. ARGUMENT.

#### A. THE PATENT IS ENTITLED TO BE BROADLY CONSTRUED BECAUSE OF THE LACK OF PRIOR ART.

It is still axiomatic that a patent is to be liberally construed in order to protect to the patentee the fruits of his invention. Such was the purpose of the constitutional grant and the statutes which Congress has subsequently passed. This rule of law has been stated in

various ways, but the Supreme Court in *Klein v. Russell*, 86 U.S. 433, 466, 22 L.Ed. 116, used these words:

“ \* \* \* The Court should proceed in a liberal spirit, so as to sustain the patent and the construction claimed by the patentee himself, if this can be done consistently with the language which he has employed.”

Again, in *Topliff v. Topliff*, 145 U.S. 156, 171, 36 L.Ed. 658, the Court said:

“ \* \* \* The object of the patent law is to secure to inventors a monopoly of what they have actually invented or discovered, and it ought not to be defeated by a too strict and technical adherence to the letter of the statute, or by the application of artificial rules of interpretation.”

This Court, in the recent case of *Brodie Co. et al. v. Hydraulic Press Mfg. Co.*, 151 F. (2d) 91, C.C.A.9, reaffirmed this rule as stated by Judge Goodman, the Judge who tried the present case:

“I think Ernst made a useful discovery. True, he did not create some new art; but, viewed in the light of the rather crude machines which antedated him, and which appear to have contributed little of a utilitarian character, the later machine which resulted from his invention is fully worthy of patent protection. Being a meritorious improvement, the rule ‘ut res magis valeat quam pereat’ applies.” (51 F. Supp. 205)

See also *Reinharts, Inc. v. Caterpillar Tractor Co.*, 85 F. (2d) 628, C.C.A. 9.

The presumption normally arising upon the issuance of a patent is materially strengthened in a case of this

sort where no art was cited by the Patent Office. Thus the normal inherent limitations introduced into claims by prior art structures do not here exist. The only art cited by defendant has not even seriously been contended to restrict the claims in suit. This art shows a group of ten cylinders mounted together for transportation on a wheeled dolly; a flat plate with an upstanding central post adapted to carry cylinders by means of a cable and crane; and a trailer adapted to carry a large group of manifolded cylinders to and from a job. None of these devices was designed for or is capable of being moved except by some mechanical aid and none of them provide the safety feature introduced by Josephian to prevent upset and injury.

Effectively, then, no real prior art is here under consideration. The patent therefore is entitled to be very liberally construed.

This particular doctrine, as concerns the lack of prior art, has been well stated recently in *Hartford-Empire Co. v. Demuth Glass Works*, 19 F. Supp. 626, 634:

“The patent in suit is \* \* \* *unlimited in scope* by prior art or by specific limitations in claim phraseology, and there is no doubt as to the validity of the patent, *therefore, there is no ground for confining the claims to the device shown and described.* *Hildreth v. Mastoras*, 257 U.S. 27, 34, 42 S. Ct. 20, 23, 66 L. Ed. 112; *Mergenthaler Linotype Co. v. Press Pub. Co. et al.* (C.C.) 57 F. 502, 505, 506; *General Electric Co. v. P. R. Mallory & Co., Inc.* (D.C.) 294 F. 562; *Continental Paper Bag Company v. Eastern Paper Bag Company*, 210 U.S. 405, 28 S. Ct. 748, 52 L. Ed. 1122.”

It must, therefore, be concluded that the patent in suit is entitled to be broadly construed and that this is so even though it is limited to a particular field in the art. It is unnecessary to warrant a broad construction that the patent start or conceive an entirely new and broad art. It is sufficient if it solves a problem in a way unknown to the prior art. *Freeman v. Altvater*, 66 F. (2d) 506, C.C.A. 8.

From this discussion and from the facts quoted above, it is apparent that the gist of the Josephian invention is a truck, capable of safely handling a plurality of cylinders, comprising a base plate and a smaller circular track on its bottom side and which has an upright and a tilted stable position. Any other construction robs the patentee of his expressed intention and destroys the grant. This construction is the one accepted and approved by the Patent Office and was clearly stated by the court below (176):

“ \* \* \* it seems to me that the claim should be interpreted in a case like this with at least sufficient liberality to give some reality to the invention rather than to make it a sort of illusory thing that anyone could change an ‘i’ or cross a ‘t’ there to get away from it. I think the evidence in this case and all the exhibits justify a more liberal interpretation of the claim.”

**B. THE CLAIMS ARE NOT LIMITED TO THE "PREFERRED FORM" SHOWN IN THE PATENT.**

The defendant's contentions seek to rob the patent and its claims of all reality by attempting to limit the scope of the claims to a specific illustration set forth in the specification and drawings. The contrary rule is so well settled that citation of authority would ordinarily be unnecessary. But the stress which defendant places on this erroneous contention requires it. In the famous *Paper Bag Case* (*Continental Paper Bag Company v. Eastern Paper Bag Company*), 210 U.S. 405, 418, 52 L.Ed. 1122, Mr. Justice McKenna stated the rule as follows:

"We think it is clear that the court considered that Liddell sought to comply with §4888 of the Revised Statutes. In other words, he filed a description of his invention, explained its principle and the best mode in which he 'contemplated applying that principle,' and did not intend to give up all other modes of application. An inventor must describe what he conceives to be the best mode, but he is not confined to that. If this were not so most patents would be of little worth. 'The principle of the invention is a unit, and invariably the modes of its embodiment in a concrete invention may be numerous and in appearance very different from each other.' Robinson on Patents, §485. The invention, of course, must be described and the mode of putting it to practical use, but the claims measure the invention \* \* \* Liddell was explicit in the declaration that there might be alternatives for the device described and illustrated by him."

Another statement of this doctrine appears in *Chicago Pneumatic Tool Co. v. Hughes Tool Co.*, 97 F. (2d) 945, 946, C.C.A. 10, where the Court said:



“ \* \* \* But it is not essential that all of the embodiments of a patent be described. *It is enough if the invention be described together with that mode which is conceived to be the best for putting it into practical use; and where that has been done, the patent is not confined to the precise mode outlined.* Tilghman v. Proctor, 102 U.S. 707, 26 L.Ed.279; Continental Paper Bag Co. v. Eastern Paper Bag Co., 210 U. S. 405, 28 S.Ct. 748, 52 L.Ed. 1122.

“Neither is it necessary that every embodiment be illustrated by the drawings unless the form of the device is the principle of the invention. Where the particular form is not an embodiment of the principle of the asserted invention, the patent is not restricted to the exact form of construction shown in the diagrammatical drawing. And a device infringes if it embodies the essential principles taught by the patent, even though there is a departure from the drawings to the extent of simple changes which would be readily conceived and made by a mechanic in the course of constructing a device on the patent. Johns-Manville Corp. v. National Tank Seal Co., 10 Cir., 49 F.2d 142; Pangborn Corporation v. W. W. Sly Manufacturing Co., 4 Cir. 284 F. 217, certiorari denied 260 U.S. 749, 43 S. Ct. 249, 67 L.Ed. 495.”

See also *Kennedy et al. v. Trimble Nursery-Land Furniture, Inc.*, 99 F. (2d) 786, C.C.A. 2.

Applying the reasoning of these cases to the facts here, it is clear that the Josephian claims are not to be limited by construction to a device which will remain in the tilted stable position. This was only the mode of operation illustrated in the drawings and is particularly applicable to a very heavy seven cylinder unit. The specification clearly



states that the claims are not intended to be limited to this form and that various other structures permitting easy and safe transportation of multiple cylinder units could be constructed in accordance with the invention. Defendant's device is so nearly identical with the illustrated form that it can hardly even be classed as an alternative construction. In any case, the fact that in tipped position, a substantially greater force is required to overturn it, makes the device respond to that part of the claims calling for the second stable position.

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**C. A DEVICE WHICH HAS EQUIVALENT ELEMENTS AND PERFORMS THE IDENTICAL FUNCTION OF THE INVENTION IS AN INFRINGEMENT.**

The substance of defendant's argument on this appeal is that infringement of the Josephian patent may be avoided by decreasing the height of the rolling track by  $3/16''$  so that its device will not remain unsupported in the tilted stable position, a position having no particular purpose nor utility.

This contention makes the doctrine of equivalents pertinent for consideration, but it must be kept in mind that defendant contends infringement is avoided by eliminating an unintended and unrequired characteristic of the invention. Mr. Josephian testified that "We can't use it in that position, we don't sell gas that way, we don't handle it that way, and we don't do anything that way" (75), and the lower Court used similar language with reference to the position in question (174).

The claims call for “a second stable position when resting on said periphery (of the track 11) and edge of said lower plate” (or substantially similar wording). Since defendant, through its expert, admitted that its depression or ring was equivalent to the Josephian track (126), *the only equivalency for the Court to determine is that of function. Walker on Patents, Deller’s Ed., Section 466, et seq.*

The test as laid down by the Supreme Court and applied in *Union Paper Bag Machine Co. v. Merrick Murphy*, 97 U.S. 120, 125, 24 L. Ed. 935, is as follows:

“Except where form is of the essence of the invention, it has but little weight in the decision of such an issue, the correct rule being that, in determining the question of infringement, the court or jury, as the case may be, are not to judge about similarities or differences by the names of things, but are to look at the machines or their several devices or elements in the light of what they do, or what office or function they perform, and how they perform it, and to find that one thing is substantially the same as another, if it performs substantially the same function in substantially the same way to obtain the same result, always bearing in mind that devices in a patented machine are different in the sense of the patent law when they perform different functions or in a different way, or produce a substantially different result.

“Nor is it safe to give much heed to the fact that the corresponding device in two machines organized to accomplish the same result is different in shape or form the one from the other, as it is necessary in every such investigation to look at the mode of operation or the way the device works, and at the result,

as well as at the means by which the result is attained.”

Another excellent statement of the same rule appears in the case of *Baldwin Rubber Co. v. Paine & Williams Co.*, 99 F. (2d) 1, 5, C.C.A. 6, where the Court said:

“The usual tests of equivalency are identity of function and substantial identity of performance. In a combination patent, *if the alleged infringing device is made up of the principal things precisely as described in the patent and attains the same result, infringement is present, though minor parts may be omitted or taken from well known equivalents.* *Eames v. Godfrey*, 1 Wall. 78, 68 U.S. 78-80, 17 L.Ed. 547; *McDonough v. Johnson-Wentworth Co.*, 8 Cir., 30 F.2d 375.”

The doctrine of equivalents has also often been stated by this Court. In *Jay v. Suetter*, 32 F. (2d) 879, 881, C.C.A. 9, Judge Dietrich stated:

“ \* \* \* Where a combination patent makes a distinct advance in the art to which it relates, as does the appellant’s invention here, the term ‘mechanical equivalent’ should have a reasonably broad and generous interpretation. *Smith Cannery Mach. Co. v. Seattle-Astoria Iron Works (C.C.A.)*, 261 F. 85. We have repeatedly held that a charge of infringement is sometimes made out, though the letter of the claims be avoided. *Westinghouse v. Boyden Power-Brake Co.*, 170 U.S. 537, 568, 18 S.Ct. 707, 722 (42 L.Ed. 1136).”

In *Stebler v. Riverside Heights Orange Growers Assoc.*, 205 F. 735, 739, C.C.A. 9, the same judge adopted the

language of the Second Circuit Court of Appeals as follows:

“The mere fact that there is an addition, or the mere fact that there is an omission, does not enable you to take the substance of the plaintiff’s patent. The question is, not whether the addition is material, or whether the omission is material, but whether what has been taken is the substance of the invention.”

He continued in his own words:

“True, the plaintiff’s rights do not extend beyond the claims in suit, and are subject to the limitations thereof; but the language of these claims is not, as argued by the defendants, to receive a narrow, literal construction. While the invention is not basic or primary, it is substantial and important and is therefore entitled to a fair range of equivalents.”

See also *Johnson Co., Inc. v. Philad Co. et al.*, 96 F. (2d) 442, C.C.A. 9.

The doctrine as applied to the present facts requires an affirmance of the conclusion of infringement. Here the infringing device possesses all the elements of the claims, operates in the same manner, performs the same functions and is effectively identical in everything except the precise thickness of the track. By reducing this dimension by 3/16", the defendant argues that infringement is avoided because the unit will not stand unsupported in the second stable position. Defendant attempts to import a requirement of immovability or rest into this position and argues that this was the major purpose of the invention. But this is a mere conclusion unsupported

by the evidence and contrary to the statement in the patent that only the preferred form is shown and described.

This reasoning ignores the fact that the defendant's device deliberately adopted all of the equivalent elements of the invention, and performs the identical function. The answer to this contention that a mere formal and immaterial change avoids infringement is found in the case of *Foster v. T. L. Smith & Co.* 244 F. 946, C.C.A. 7, a case similar on its facts to the present controversy. In that case the preferred form of the invention, a cement mixer, showed a frame perpendicular to the receptacle's axis of revolution, but this limitation was not included in the claims. The Court said, at pages 953, 954:

“There is no contention that appellees' commercial machine does not conform to the claims in suit in all respects except one; and that is in respect to ‘the tiltable frame in which the receptacle is supported.’ In the specific claims, which are addressed to the preferred form of structure, the tiltable frame is required to be in a plane to which the axis of the receptacle's revolution is perpendicular. In the claims in suit there is no limitation with respect to the relation of the plane of the frame and the line of the axis of revolution. And if the preferred form of tiltable frame were placed in a plane in which the line of the axis of revolution would lie, there would seem to be no basis whatever for saying that the structure would not be within the letter and spirit of the claims in suit \* \* \*

“It is to be remembered that the specification told the persons who proposed to use the invention as described in the claims in suit that they could employ



a frame of any form adapted for supporting the receptacle \* \* \*

“Appellant’s structure very plainly has been taken from appellee’s commercial structure. They are exactly the same in operation and result. Two small differences appear. One is that the circular toothed rack is placed slightly away from the exact ‘largest diameter’ or ‘middle’ of the receptacle. The other is that the mouth of the pot-shaped receptacle is prolonged so that the receptacle cannot be revolved through the 360 degrees by reason of striking the bottom of the circle. But the circular toothed rack is so near the largest diameter of the receptacle that all of the advantages of the patent are secured in that respect. And with respect to tiltability, all of the advantages of loading on one side and discharging on the other are obtained as fully as in the patented structure \* \* \* *These changes impress us as having been intentionally devised for the purpose of creating a verbal differentiation. But infringement is not thereby escaped, if the defendant has actually appropriated the real substance of the invention.* Adam v. Folger, 120 Fed. 260, 56 C.C.A. 540; United States Metallic Packing Co. v. Hewitt Co. (D. C.) 220 Fed. 171.”

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**D. INFRINGEMENT IS A QUESTION OF FACT, THE DETERMINATION OF WHICH IS NOT TO BE REVERSED UNLESS MANIFEST ERROR APPEARS OR THERE IS NO EVIDENCE TO SUPPORT IT.**

It is believed that the lower Court found infringement, validity being admitted, in accordance with the principles set forth above. It is well settled that the question of infringement is one of fact and that a determination will



not be set aside unless it is clearly erroneous or entirely unsupported by the evidence. This doctrine has been closely adhered to by this Court for many years, most recently in *Brodie Co. et al. v. Hydraulic Press Mfg. Co.*, 151 F. (2d) 91, C.C.A. 9, and was stated by this Court in *Reinharts v. Caterpillar Tractor Co.*, 85 F. (2d) 628, 630, C.C.A. 9:

“The question of infringement also is a question of fact.” (citing Supreme Court cases)

“On both questions—the question of validity and the question of infringement—the trial judge, who personally heard the evidence and personally inspected the accused tractors, decided against appellant. *His findings, unless clearly wrong, should not be disturbed.*” (citing cases)

The defendant here has not contended that the findings of the lower Court in this respect are not supported by substantial evidence nor has it pointed out wherein Judge Goodman’s conclusions were clearly erroneous. Having failed to do so, it is apparent that defendant has not carried its burden of proof as required by the cases cited above.

All that defendant has done here is to contend for an interpretation of the claims which would import, as a limitation of the claims, an effectively useless function of the device—that of standing like the Leaning Tower of Pisa without external support. Such an interpretation of the claims would effectively emasculate them and permits the defendant to appropriate the heart of the Josephian invention. It is difficult to imagine a more inequitable construction; one which limits the patentee’s

device to a structure possessing a useless and incidental function, leaving the gist of his invention for the use and benefit of his competitors.

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#### **E. THE DEFENDANT'S BRIEF.**

The primary contentions of defendant are felt to have been completely answered in other sections of this brief. But in several instances (pp. 8, 20 and 21) the Brief on Behalf of Appellant erroneously charges that plaintiff's counsel attempted to mislead the lower Court by introducing a "grossly misrepresentative drawing", Plaintiff's Exhibit 6.

This charge is false and is not supported by the record. It would have been ridiculous for plaintiff to urge the Court to determine infringement from a drawing when the actual devices and blue print were before the Court (Plaintiff's Exhibits 7A, 7B, Defendant's Exhibit E). At the time of admission, plaintiff's counsel, stated to the Court (63):

"I expect to put the defendant's device in evidence, or a photograph of it, so there is no question about that."

That the Court understood that the drawing was illustrative only and was in no way confused is obvious from its subsequent statements (133):

"\* \* \* He said it was not accurate as to dimensions. The blueprint which you offered, and the testimony supported it, showed it was inaccurate. \* \* \* Counsel's exhibit is only to show generally how it looked rather than being an accurate portrayal. \* \* \*

“\* \* \* It seems to me \* \* \* that it is unnecessary to point out on the diagram something that is admitted already, namely that it is not clear—”

This is a bald attempt on defendant's part to obscure the issues and may be completely ignored. Plaintiff introduced the infringing device into evidence for consideration by the Court and the drawing was introduced only for convenience in discussing the structure of the device and was intended to and indeed did not serve any other purpose.

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## V. THE OPINION OF THE LOWER COURT.

Judge Goodman's opinion, delivered orally at the close of the evidence, is thought to be a masterly statement of the facts and the law of this case. It is a logical, well reasoned decision, and indicates an intelligent and common sense approach to the issues. Because it is so concise and indicates such a clear understanding of the issues, pertinent portions are reproduced here (173-176):

“Along comes Mr. Josephian and he devises this ring by which it is protected from falling over. Now, your client makes that ring a little narrower with the result that it does not tip over because it comes back to its original position. The object of the invention is not to perform some example with mechanics or mathematics. It is to accomplish a desired result, isn't it, and shouldn't we measure these bursts of genius we have in terms of what they are aimed at rather than to prove some mathematical formula or mechanical formula?

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“You do not think that the main object of this invention was to create a sort of Leaning Tower of Pisa? I mean there is nothing to be accomplished by having a group of cylinders get themselves into this position, except it might have created some conjecture as to why that is, but the object is not to do that. The object is to get this thing in a stable position so it won't fall over. The way that is done is this. Surely the inventor did not have in mind all he was going to do was to bring about a situation where he could display to the trade these devices set up in this position because that would not interest them. What possible profit could that bring about? It has been said he could not sell the object in that way. That would not be persuasive. No salesman could gain anything by saying, ‘My boss, Mr. Josephian, has got a set of cylinders that he is able to stand up on edge that way.’ That would not aid him at all. It seems to me the thing we have to consider is what is the object, what is the main thing you are aiming at?

\* \* \* \* \*

“I feel that way about because looking at it from a rather common sense practical point of view the device your client made was built in the same way, uses the same ring, and makes a little difference in the ring, and unquestionably he wanted to use it for the accomplishment of the same objectives of stability and maneuverability. I am not impressed by the argument that this particular ring, when the defendant knew about plaintiff's patent and what he was using it for, was put there for the purpose of facilitating the use of a truck, to get it on the truck. That does not particularly impress me. Apparently this is not the kind of case where the Court is particularly

required to go into the invention phase of the matter. As Mr. Boyken has said, it is not some revolutionary thing like the atomic bomb, but in its small way it appears to be a practicable and new way of handling these things. Your claim adopted that slight variation of the same plan, and it appears to me that it is a case in which an injunction should be granted.

“\* \* \* it seems to me that the claim should be interpreted in a case like this with at least sufficient liberality to give some reality to the invention rather than to make it a sort of illusory thing that anyone could change an ‘i’ or cross a ‘t’ there to get away from it. I think the evidence in this case and all the exhibits justify a more liberal interpretation of the claim.”

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## VI. CONCLUSION.

The portions of the lower Court's opinion just quoted make it clear that the issue here is a simple one, involving only infringement. The defendant has made and <sup>USED</sup>~~SOLD~~ devices having elements corresponding to the claims of the patent in suit. The patent is for a unique and worthwhile device which performs a function never performed in the prior art and is, as a consequence, entitled to a broad and fair construction. Defendant's device contains all of the required elements and performs all of the same functions and is the full equivalent of the invention. Defendant should not be permitted to appropriate the invention of plaintiff and then escape infringement by a tortured, impractical construction of the patent in suit.

For these reasons, it is respectfully urged that this Court should affirm the decision of the lower Court finding the patent valid and infringed.

Dated, San Francisco, California,  
March 28, 1947.

Respectfully submitted,

BOYKEN, MOHLER & BECKLEY,

A. W. BOYKEN,

W. BRUCE BECKLEY,

*Attorneys for Appellee.*

REGINALD L. VAUGHAN,  
*Of Counsel.*